



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/645,181

08/21/2003

Hiroshi Satomi

03500.014419.1

7320

5514

7590

09/30/2008

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

DANNEMAN, PAUL

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

09/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/645,181	Applicant(s) SATOMI ET AL.	
	Examiner PAUL DANNEMAN	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 385,386,389,391-393,401 and 409 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 385, 386,389,391-393,401 and 409 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 June 2008 has been entered.

Status of the Claims

2. Claims 387-388 and 410-411 have been cancelled.
3. Claims 385, 389, 393, and 401 have been amended.
4. All Pending Claims 385-386, 389, 391-393, 401, and 409 have been examined in this application.

Claim Objections

5. Claim 389 is objected to because of the following informalities: Claim 389 is dependent on a canceled Claim 387. For purposes of this examination the Examiner is interpreting ***Claim 389 to be dependent on Claim 385***. Appropriate correction is required.

6. Claim 389 is objected to because of the following informalities: Claim 389 recites “***wherein if the determined charge amount of the printout of the output information to be printed out together with the additional information becomes negative, said determining step determines the charge amount for the print as zero.***” The phrasing is very convoluted, therefore the Examiner is recommending the following wording: “***if the credit for the additional information added exceeds the printing cost of the output information the customer is not charged for the print job***”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 385-386, 389, 391-393, 401 and 409** are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, US 4,839,829 in view of Kawai et al. US 6,891,636 B1 hereafter known as Kawai.

Claims 385, 393 and 401:

With regard to the limitation:

- ***A memory for storing a computer program and a processor for executing the computer program.***

Freedman in at least FIG.1A, FIG.1B, Column 3, lines 57-60, Column 4, lines 42-67 and Column 5, lines 1-23 discloses a programmed, networked computer having a memory an output/input means for use by a printing requester.

With regard to the limitation:

- ***An image forming method for charging a user for printout of output information over a network.***

Freedman in at least Column 1, lines 10-17 and Column 2, lines 38-51 discloses an invention that quickly assesses a customer's specific printing requirements and provides the user with instantaneously provided accurate information regarding costs, print facility capacity, scheduling, etc. Freedman still further discloses the employment of request/response sequences and the information gathered from the customer by this technique is correlated with a database of stored information from a specific or various printing facilities.

With regard to the limitation:

- ***Output information is registered to a user.***

Freedman in at least Column 1, lines 17-41 further discloses that the system interacts with the user to collect, compare, and store information regarding the user and the parameters related to the user's needs (i.e., cost requirements, photos, pictures, graphics, deadlines, number of documents to be printed, colors used, kinds of paper, typeface to be used, etc). Freedman in at least Column 7, lines 62-67, Column 8, lines 1-15 and Figs 2A and 2B discloses the system requiring the user to log onto the system using a password or key and entering customer identification information and a job identification number or code to facilitate tracking of the printing job.

Freedman does not specifically disclose the following limitations of automatically-selecting which additional information is to be printed out up to a maximum limit.

- ***Automatically-selecting which additional information will be printed out and then printing out the additional information up to a predetermined maximum limit.***

However, Kawai in at least Column 7, lines 5-27 discloses a copying machine with a fee charging device containing an advertisement selection function connected with an advertisement image memory for storing multiple information images in advance. Kawai in at least Column 13, lines 15-19 discloses that it is possible to provide a function for the copying machine to select optimum images based on the time zone and other factors. Kawai in at least Column 14, lines 30-42 and Column 16, lines 13-31 discloses the additional image is automatically selected in rotation by the control unit. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Freedman Automated Printing Control System with Kawai's Automatic Image Selection System and to further modify Freedman/Kawai's control unit to have re-settable predetermined limits for other counting purposes with the motivation of providing a system which is fully automatic with regards to information which is automatically selected and having a counter to limit the number of time such information may automatically be selected.

With regard to the following limitation:

- ***Allowing additional information to be added to the original output information thereby reducing the overall printing cost.***

Freedman does not specifically disclose allowing a discount on the print job based on including additional information or automatically-selecting which additional information will be printed out per se, however Kawai in at least Column 7, lines 5-27 discloses a copying machine with a fee charging device containing an advertisement (other information) selection function connected with an image memory for storing multiple information images in advance, a fee charging memory for storing the aggregate number of copies printed with the additional information, as well as the

aggregate fees to be charged to the advertiser and a counting unit for counting the number of sheets printed with advertisement. Kawai in at least Column 13, lines 25-48, and lines 60-62 discloses a control procedure for altering the copy fees based on the display location of the list of information if such information was requested by the user.

Therefore, it would have been obvious, at the time of the invention, to modify Freedman's Automated Printing Control System with Kawai's fee reducing charge for including an advertisement (additional information) with the motivation of providing a customer of the printing (copy) service an option to reduce their printing costs by a prescribed amount based on the advertisement.

With regard to the following limitation:

- ***Determining, outputting and displaying the amount user will be charged for the printing to a display.***

Freedman does not specifically disclose the above limitation per se, however, Kawai in at least Column 7, lines 60-67 further discloses a display unit displaying a message indicating an amount charged to the copy user based on the inclusion of additional information on the copy user's prints. Kawai in at least Column 10, lines 4-9 discloses fees to the copy user and the information provider can be altered in a proper ratio based on the copying productivity. Therefore it would have been obvious, at the time of the invention, to one of ordinary skill in the art to modify Freedman's Automated Printing Control System with Kawai's display with the motivation of providing an interested party with cost data pertinent to a printing job.

With regard to the following limitation:

- ***Output format of the additional information indicates a position on a sheet.***

Freedman in at least Column 10, lines 11-14 discloses inserting an additional graphic (advertisement, form or coupon) on the last or some other page at some point in the text.

Claim 386:

With regard to the limitations:

- ***Output information designated by the user contains plurality types of output information.***
- ***First value information corresponds with the plural types of output information.***

Freedman in at least Column 3, lines 49-67, Column 4, lines 1-2, Fig.1A and Fig.1B further discloses an invention comprised of a system for automated control of the printing of a work. The system comprises printing requester terminals and printing facility terminals. The printer requester terminal is connected to a computer for receiving and storing the printing parameter information for a print request. Freedman in at least Column 3, lines 33-45 further discloses that the print facility can conveniently modify job orders based on a customer request, assess the present status of a printing job, and calculate the adjusted costs involved in such modifications.

Freedman in at least Column 4, lines 25-35 further discloses that the term "printing" encompasses any and all processes and/or the use of any type of machine or device which can be employed or utilized for preparing and producing imaging on a substrate which can be machine or humanly read, including, but without limitation: letter press, intaglio, gravure, lithographic, etc. Freedman in at least Column 5, lines 1-23 still further discloses the communication link between the printing requester terminals, the printing facility terminals and the computer may be regular phone lines (PSTN), leased lines adapted for transmission of high speed data, a packet switch network, etc.

Freedman in at least Column 8, lines 24-26 further discloses allowing the customer to enter printing parameters to establish a new custom design template. Freedman in at least Column 10, lines 1-14 further discloses allowing the customer to approve the print parameters and if it's desirable allowing the insertion of an additional graphic or an advertisement (form or coupon) into the print job. Freedman in at least Column 10, lines 15-35 calculates the cost information of utilizing alternate pricing strategies based upon usage of different printing or publishing equipment and based upon the parameter of differing print facilities and print parameters.

Claims 389 and 391:

With regard to the limitation:

- ***Determining the charge amount on a monetary basis based on an initial bid and a subsequent revision based on a change of the initial print order by the addition of advertisements.***

Freedman does not specifically disclose providing a credit for including advertisements within the printed material per se. Freedman in at least Column 9, lines 64-67 and Column 10, lines 1-14 discloses the computer calculating the total number of finished pages for the job and displaying to the requester all publication design parameters. Alternatively, it may be desirable to insert an additional graphic at some point in the text to fill up the last page or to insert an advertisement, form or coupon on the last or some other page for efficient usage of all pages. Freedman in at least Column 10, lines 15-35 further discloses that if the requester makes no further changes the computer then calculates cost information utilizing alternate pricing strategies. The requester is further provided with verification of the parameters, prices, etc. Freedman in at least FIG 3A and 3B and Column 10, lines 55-63 still further discloses providing a cost estimate for a particular job. Freedman in at least Column 3, lines 19-46 still further discloses a client opting to modify a standing printing order and the printing facility having to adjust the cost and production schedules accordingly. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art to modify Freedman's automated printing facilities pricing unit to include credits for additional information (advertisements) with a maximum limit on the amount of credit based on the cost of a print job not going below zero and the maximum credit based on the reaching the maximum limit of the number of times the additional information is included in the print jobs.

However, Kawai in at least Column 2, lines 25-32, FIG.2B, and FIG.2C discloses an image forming system where an advertisement image is printed on the white space or on other locations. Kawai in at least FIG.7 further discloses a fee control procedure based on the complexity of an advertisement. Kawai in at least Column 4, lines 49-52 discloses charged a

Art Unit: 3627

user a copying fee that reflects the credit applied due to including an advertisement in the print job. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Freedman's Automated Printing Control System with Kawai's advertisement inclusion, print (copy) fee reducing system with the motivation of enhancing the success of an advertisement, while providing an incentive to users to include advertisements in their print jobs (Kawai, Column 4, lines 52-54).

Claims 392 and 409:

With regard to the limitation:

- ***Registering and storing the printing information in a database.***
- ***Automatically selecting the information to be printed out in response to entry of the output information identification code.***

Freedman in at least Column 2, lines 45-47 discloses a data base of stored information. Freedman in at least Column 7, lines 42-61 further discloses obtaining information from the printer requester and storing information concerning the work to be printed. Column 3, lines 49-67, Column 4, lines 1-2, Fig.1A and Fig.1B further discloses a system for automated control of the printing of a work. The system comprises printing requester terminals and printing facility terminals. The printer requested terminal is connected to a computer for receiving and storing the printing parameter information. The computer interacts with the printing facility terminal for receiving and storing pricing and administrative information concerning the printing of the work. Freedman in at least Column 7, lines 62-67, Column 8, lines 1-15 and Figs 2A and 2B discloses the system requiring the user to log onto the system using a password or key and entering customer identification information and a job identification number or code to facilitate tracking of the printing job. Freedman in at least Column 7, lines 37-41 further discloses that the printing of a work is automated.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

26 September 2008

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627